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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,219	10/29/2003	Herbert H. Loeffler	1159.1009-007	5251

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EXAMINER

HYUN, PAUL SANG HWA

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/696,219

Applicant(s)

LOEFFLER ET AL.

Examiner

Paul S. Hyun

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 10-14, 17 and 18 is/are rejected.
- 7) ☒ Claim(s) 6-9, 15 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/29/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claims 2-12 and 14-18 are objected to because of the following informalities: The term "An apparatus" should be changed to "The apparatus" since a proper antecedent basis for the term is established in the independent claims.

Appropriate corrections are required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 10 recites a well capable of holding an aliquot of reagent over the fluid port. However, according to the Specification and the Drawings, it appears that the well is a part of port 19 (see line 29 page 13 – line 1 page 14 & Fig. 6). According to the claim, the well is located above port 19.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 10-14, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stapleton et al. (US 5,346,672) in view of Saxon et al. (US 4,927,765).

Stapleton et al. disclose a device for preserving biological specimens. The device comprises a specimen disposed on a microscope slide 18 enclosed by flanges 46 and cover rims 40 that form a releasably sealed chamber 32 surrounding the specimen. The device also comprises a conical fluid port 56 located in the wall of the chamber through which fluids can be added or removed. To prevent contamination of the specimen, the device comprises a valve in the form of a flexible bladder 60 that plugs port 56 and vents chamber 32 (see Figs. 5 & 6 and lines 1-16 col. 12). The bladder 60 is also capable of holding an aliquot of reagent in the fluid port. However, the reference does not disclose a conduit or an actuator as recited in the claim.

Saxon et al. disclose an automated reagent dispenser. The dispenser comprises a conduit in the form of port 23 through which negative and positive pressure flows as well as an actuator that moves the dispenser to a desired location to dispense the reagent (see lines 31-41 col. 4).

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide an automated reagent dispenser as taught by Saxon et al. to the device disclosed by Stapleton et al. such that the port through which the negative and positive pressure flows forms a seal with port 56 of the Stapleton et al. device. The modified device would allow one to introduce reagents into chamber 32 automatically and cleanly. See In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958), a case in which the Court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is considered an obvious expedient.

It also would have been obvious to one of ordinary skill in the art to provide a second port and a second conduit to the modified Stapleton et al. device so that a second reagent can be dispensed into chamber 32 of the device. See In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960), a case in which the Court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced.

It also would have been obvious to one of ordinary skill in the art to provide a plurality of chambers to the modified Stapleton et al. device such that the device positions the actuator at a selected chamber. The modified device would be able to accommodate a plurality of microscope slides. See In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

Allowable Subject Matter

Claims 6-9, 15 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Stapleton et al. disclose a device for preserving biological specimens. The device comprises a specimen disposed on a microscope slide 18 enclosed by flanges 46 and cover rims 40 that form a releasably sealed chamber 32 surrounding the specimen. The device also comprises a conical fluid port 56 located in the wall of the chamber through which fluids can be added or removed. To prevent contamination of the specimen, the device comprises a valve in the form of a flexible bladder 60 that plugs port 56 and vents chamber 32 (see Figs. 5 & 6 and lines 1-16 col. 12). The bladder 60 is also capable of holding an aliquot of reagent in the fluid port.

Moreover, it would have been obvious in view of Saxon et al. (US 4,927,765) to provide an actuator means to accommodate a conduit into port 56 of the Stapleton et al. device so that reagents can be added to chamber 32 of the device. However, there is no analogous art that suggests or teaches the use of a piston disposed in a movable conduit to open a flexible valve disposed in a port.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul S. Hyun whose telephone number is (571)-272-8559. The examiner can normally be reached on Monday-Friday 8AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PSH 11/18/05


Jill Warden
Supervisory Patent Examiner
Technology Center 1700